REMARKS

I. Claim Status

Claims 1, 4, and 7-10 are currently pending. Claims 2-3, and 5-6 have been canceled without prejudice herein. Claims 1, 4, and 7-10 have been amended herein. Those amendments are supported in the specification and claims as originally filed. Specifically, the recited compound is exemplified in Example 3. Accordingly, no new matter has been added herein.

II. Rejection under 35 U.S.C. § 103(a)

The Examiner rejected claims 1-10 under 35 U.S.C. § 103(a) as allegedly being unpatentable over WO 97/12874 to Karjalainen et al. ("Karjalainen") either alone or in view of WO 01/251472 to Huhtala et al. ("Huhtala"). Final Office Action at 3. Applicants disagree with this rejection and assert that it does not apply to the presently pending claims.

Applicants respectfully point out that the presently pending claims recite 4-[6-(2,2-dimethylpropanoyloxy)indan-1-ylmethyl]-1*H*-imidazole or a pharmaceutically acceptable salt or hydrate thereof. Applicants assert that those compounds and the corresponding method of treatment and pharmaceutical composition claims (e.g., presently pending claims and claims 4 and 7-10 of Applicants' June 29, 2007, Amendment) are non-obvious over Karjalainen either alone or in combination with Huhtala. Specifically, the Examiner has failed to establish a *prima facie* case of obviousness for the reasons discussed below.

Rejection over Karjalainen Alone

The Office asserts that "[t]he difference between the compounds of the prior art and the compounds instantly claimed is that the instant claimed compounds are

generically described in the prior art." Final Office Action at 3. Applicants respectfully point out that the presently recited compounds 4-[6-(2,2-dimethylpropanoyloxy)indan-1-ylmethyl]-1*H*-imidazole or a pharmaceutically acceptable salt or hydrate thereof are not members of the express genus of Karjalainen because R_6, R_7, and R_8 are not defined to include an ester group, let alone the presently claimed pivaloyl group. *See* Abstract.

Similarly, the presently claimed compounds are not expressly disclosed as possible esters of that genus. Although, Karjalainen specifically contemplates "lower alkyl esters, such as the methyl, ethyl and propyl esters," (page 4, lines 27-28), the presently recited compounds (as previously claimed in claims 4 and 7-10 in Applicants' June 29, 2007, Amendment) possess a pivaloyl ester and not a methyl, ethyl, or propyl ester. Moreover, not one of the specific compounds disclosed in Karjalainen on pages 13-39 includes ***any*** ester functional group. Accordingly, one of ordinary skill in the art would not have been able to at once envisage the presently claimed invention as required under *In re Petering*, 301 F.2d 676, 681 (C.C.P.A. 1962); *see also* M.P.E.P. § 2144.08; *In re Ruschig*, 343 F.2d 965, 974 (C.C.P.A. 1965) (Reasoning that rejection of claimed compound in light of prior art genus based on *Petering* is not appropriate where the prior art does not disclose a small recognizable class of compounds with common properties.) Therefore, for the reasons presented herein, this rejection should be withdrawn.

Rejection over Karjalainen and Huhtala

For the reasons discussed above, the presently pending claims are non-obvious over Karjalainen in view of Huhtala because Huhtala fails to compensate for Karjalainen's deficiencies. Specifically, even though Huhtala contemplates ester

functional groups on the benzene ring (page 8, third full paragraph), its disclosure is no more expansive than Karjalainen's. A pivaloyl ester is not expressly disclosed as a potential ester: "Examples of such esters include esters of aliphatic or aromatic alcohols, e.g., lower alkyl esters, e.g., methyl, ethyl and propyl esters." *Id.*

Moreover, as Applicants have already discussed on the record, the Office has erred by combining Karjalainen and Huhtala. A *prima facie* case of obviousness cannot be established when the cited references teach away from one another. *See* M.P.E.P. § 2145. That is exactly the situation in the present case. Karjalainen teaches a class of compounds, which are generally "very selective alpha2 ***agonists***," whereas Huhtala discloses compounds generally "exhibiting alpha2-***antagonistic*** activity." Karjalainen at page 1, lines 8-9; Huhtala at page 14, first full paragraph. As discussed in Applicants' January 30, 2008, Response at pages 7-8, the compounds of Huhtala necessarily require a bulky $(CR_2R_3)_r$-R_1 group–a feature that does not overlap with the compounds disclosed in Karjalainen. Absent that sterically cumbersome group, the compounds disclosed in Karjalainen have the opposite activity at the alpha2 adrenoreceptor, and as a result are used to treat different diseases and conditions. *Compare* Karjalainen at page 1, lines 8-14 to Huhtala at page 14, second full paragraph. In fact, compounds of Huhtala, i.e., antagonists, "may also be used for the ***reversal*** of the effects of alpha2-agonists," i.e., the compounds of Karjalainen. Huhtala at pages 13-14 (emphasis added). Therefore, not only does Huhtala fail to compensate for Karjalainen's deficiencies, it also teaches away from its combination with Karjalainen. Therefore, Applicants respectfully request withdrawal of this rejection.

CONCLUSION

Applicants respectfully request that this Amendment under 37 C.F.R. § 1.116 be entered by the Examiner, placing claims 1, 4, and 7-10 in condition for allowance. Applicants submit that the proposed amendments of those claims do not raise new issues or necessitate the undertaking of any additional search of the art by the Examiner, since all of the elements and their relationships claimed were either earlier claimed or inherent in the claims as examined. Therefore, this Amendment should allow for immediate action by the Examiner.

In view of the foregoing remarks, Applicants submit that this claimed invention, as amended, is neither anticipated nor rendered obvious in view of the prior art references cited against this application. Applicants therefore request the entry of this Amendment, the Examiner's reconsideration of the application, and the timely allowance of the pending claims.

Please grant any extensions of time required to enter this response and charge any additional required fees to our Deposit Account No. 06-0916.

Respectfully submitted,

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